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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,669	04/08/2004	Boris Volfson	34120-3	8026

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WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP  
111 MONUMENT CIRCLE, SUITE 3700  
INDIANAPOLIS, IN 46204-5137

EXAMINER

PRONE, JASON D

ART UNIT PAPER NUMBER

3724

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/820,669	Applicant(s) VOLFSON ET AL.	
	Examiner Jason Prone	Art Unit 3724	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.  
     4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 21-33 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/8/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 1-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 27 June 2006. It is noted that applicants arguments regarding group Vi (claim 33) is persuasive and therefore, claim 33 will be examined with the elected group.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

### ***Specification***

3. The disclosure is objected to because of the following informalities: On page 6 lines 4-6, the sentence "The end of the spring 110 away from the pusher 100 contacts a stationary bearing surface in the lower housing." does not appear to be accurate. Figure 2 shows this end of the spring inside the rail 36 and not touching a bearing surface inside the housing. On page 8 line 6, the phrase "Continued pressure on the push knob 56 moves the rail downward" does not appear to be accurate. Rail 36 is

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connected to the end retainers 34 in Figure 1. In order for the rail to move downward, there would have to be a groove or some kind of indentation allowing the rail to move.

Appropriate correction is required.

### ***Claim Objections***

4. Claims 21 and 22 are objected to because of the following informalities: In claim 21, it is disclosed that the cutting assembly rotates but the specification only supports a portion of the cutting assembly can rotate. In claim 21, the phrase "wherein said cutting assembly is rotatable to controlably position a selected one of said blades in an operative position relative to the base" is not accurate and should be replaced with "wherein said cutting assembly has a rotatable portion that controlably positions a selected one of said blades in an operative position relative to the base". Then in claim 22, the phrase "wherein the cutting assembly comprises a knob rotatable to controllably position a selected one of said blades in an operative position" should be replaced with "wherein said rotatable portion to controllably position a selected one of said blades in an operative position comprises a knob". As currently written the cutting assembly rotates and the knob rotates, it could be unclear that these rotations are the same. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Evans (5,611,255).

Evans discloses the same invention including a base (11), a rail mounted to the base (24), a cutting assembly slidably mounted on the rail (17), a plurality of blades mounted in the cutting assembly (18), and wherein the cutting assembly is rotatable to selectively position a desired one of the blades in an operative position relative to the base (Fig. 3).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 21-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Lin et al. (6,951,159).

In regards to claim 21, Lin et al. disclose the same invention including a base (21), a rail mounted to the base (22), a cutting assembly slidably mounted on the rail (23), a plurality of blades mounted in the cutting assembly (Fig. 6), and wherein the cutting assembly is rotatable to selectively position a desired one of the blades in an operative position relative to the base (Column 5 lines 24-67).

In regards to claim 22, Lin et al. disclose the cutting subassembly comprises a knob rotatable to controllably position a selected one of the blades in an operative position (231).

In regards to claim 23, Lin et al. disclose the knob includes indicia indicating a corresponding selected blade (Fig. 6).

In regards to claim 24, Lin et al. disclose the cutting assembly defines positive stops engageable with the knob to indicate when a blade is in the operative position (2311, 2312, 2313).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 22, 25, 26, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans in view of Takacs (3,108,349).

Evans discloses the invention, with regards to claims 25, 26, 30, and 33, including the cutting assembly is rotatable to at least 4 positions to selectively position the blades (Fig. 3), the plurality of blades comprises at least 3 circular blades (18), the cutting assembly controls a rotatable shaft and wherein the blades are radially positioned around the shaft such that rotation of the shaft controllably positions a selected one of the blade (17), and a housing (Fig. 3).

However, Evans fails to disclose the cutting assembly comprises a knob to control the position of the blades and the shaft, the cutting assembly comprises a spring outwardly biasing the knob, and a pusher disposed between the spring and the blades.

Takacs teaches that it is old and well known in the art of pivotal blades to incorporate a knob to control the position of the blades and the shaft (25), the cutting assembly comprises a spring outwardly biasing the knob (Fig. 1), and a pusher disposed between the spring and the blades (Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Evans with the knob structure, as taught by Takacs, to allow the user to rotate the cutting assembly more easily.

11. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans in view of Takacs as applied to claims 21, 22, 25, and 26 above, and further in view of Bodo (5,322,001). Evans in view of Takacs disclose the invention including the circular blades includes a straight edge blade (18 in Evans), the cutting assembly is downward movable towards the base to engage the selected blade with the work piece (about item 24 in Evans), and the cutting assembly comprises a clutch that prevents the selected blade from moving (21 in Evans).

However, Evans in view of Takacs fail to disclose the blades include a scalloped edge blade and a perforating blade.

Bodo teaches that it is old and well known in the art of web trimmers to incorporate a scalloped edge blade (74) and a perforating blade (76). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Evans in view of Takacs with the different shaped blades, as taught by Bodo, to allow the user to create different shaped cuts.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Casper, Cornell et al., Mori et al., Volfson, Schultz et al., Carrillo et al., Tseng, Shultz et al., AccuCut A200 Dial-A-Blade 12" trimmer, and AccuCut A200 Dial-A-Blade 5-Sheet Rotary Trimmer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:00-4:30, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

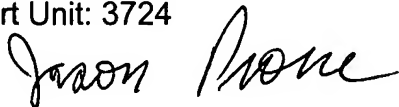
September 27, 2006



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A handwritten signature in black ink that reads "Jason Prone". The signature is written in a cursive, flowing style.

Patent Examiner

Jason Prone

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